

Remarks

Reconsideration of this application is respectfully requested.

Entry of the forgoing Amendment under 37 C.F.R. § 1.116 is respectfully requested. The Amendment clarifies the language of independent claims 1, 16, and 20 in accordance with the examiner's comments. In Paragraph 11 of the Office Action, the Examiner stated that he agrees that the coating of Lutz is not a golf ball cover layer but states that the claims are not drawn to a golf ball cover layer. The independent claims have been amended to positively recite the step of injection molding a golf ball cover layer. Claim 1 has been amended to recite "injecting the reaction mixture into the mold to form a golf ball cover layer over the golf ball product therein." Claims 16 and 20 have been amended to recite the step of "molding a golf ball cover layer about said golf ball component".

Applicants submit that the foregoing amendments comply with a requirement of form which was set forth in the previous Office Action. Further, the amendments present the rejected claims in better form for consideration on appeal.

In the Amendment mailed December 29, 2003 applicants explained in detail why the claims were not anticipated or rendered obvious by Lutz. Specifically, Lutz merely describes a urethane coating on a golf ball cover. Lutz does not describe forming a cover by injecting a polyurethane thermoset reaction mixture into a mold.

Applicants will not burden the Examiner with a repetition of the arguments submitted in the previous Amendment and incorporate those arguments herein by reference.

Claims 16-20 were also rejected under 35 U.S.C. § 102(e) as being anticipated by Kennedy 6,290,614. However, as stated in the Amendment mailed December 29, 2003, Kennedy is not a proper reference under 35 U.S.C. § 102(e) for either of two reasons:

1. The effective filing date of claims 16-20 is October 21, 1998, whereas the effective filing date of the claims of Kennedy is October 1, 1999.
2. Applicants conceived and reduced to practice the invention of claims 16-20 before the filing date of Kennedy's parent application Serial No. 09/040,798.

The Preliminary Amendment filed September 19, 2002 explains in detail on pages 8-12 why applicants' claims 16-20 are entitled to a filing date of October 21, 1998, the filing date of applicants' parent application Serial No. 09/176,445, and why the effective filing date of Kennedy is October 1, 1999.

Pages 12-13 of the Preliminary Amendment explain why claims 16-20 cannot be rejected as unpatentable over Kennedy under 35 U.S.C. § 102(e) on the basis of either Kennedy or Kennedy's parent application, Serial No. 09/040,798. Applicants conceived and reduced to practice their invention before the filing date of Kennedy Serial No. 09/040,798 as stated in the Declaration Under 37 C.F.R. § 1.131 which was mailed to the Patent and Trademark Office on September 18, 2002.

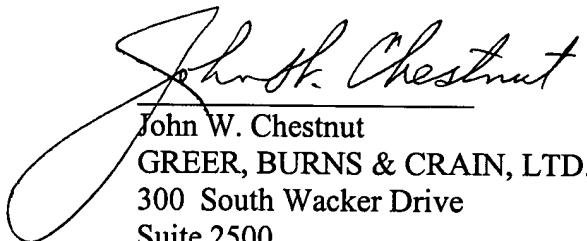
Applicants repeated their arguments regarding the inapplicability of Kennedy as prior art because of the Rule 131 Declaration in the Amendment which was mailed to the Patent Office on September 29, 2003. However, the Examiner has never referred to that Rule 131 Declaration. MPEP 715.09 states that "all admitted affidavits and declarations are acknowledged and commented upon by the examiner in his or her next succeeding action." Since the Examiner has yet to acknowledge or comment on the Declaration,

applicants do not know what the Examiner's position on the Declaration is and do not know whether further action should be by way of petition or by appeal. Applicants therefore respectfully request that the Examiner state his position with respect to the Rule 131 Declaration and why the Declaration has not removed Kennedy as a reference.

In view of the forgoing, reconsideration of this application is respectfully requested.

Respectfully submitted,

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John W. Chestnut
GREER, BURNS & CRAIN, LTD.
300 South Wacker Drive
Suite 2500
Chicago, Illinois 60606